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| APPLICATION NO.    | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|--------------------|-------------|----------------------|---------------------|------------------|
| 09/660,852         | 09/13/2000  | Gerard Vahee         | END920000075US1     | 7942             |
| 7590               |             | 09/03/2009           |                     |                  |
| John R. Pivnichny  |             |                      |                     |                  |
| IBM, N50/040-4     |             |                      |                     |                  |
| 1701 North Street  |             |                      |                     |                  |
| Endicott, NY 13760 |             |                      |                     |                  |
|                    |             |                      | EXAMINER            |                  |
|                    |             |                      | FRENEL, VANEL       |                  |
|                    |             |                      | ART UNIT            | PAPER NUMBER     |
|                    |             |                      | 3687                |                  |
|                    |             |                      | MAIL DATE           | DELIVERY MODE    |
|                    |             |                      | 09/03/2009          | PAPER            |

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

|                              |                                      |                                     |  |
|------------------------------|--------------------------------------|-------------------------------------|--|
| <b>Office Action Summary</b> | <b>Application No.</b><br>09/660,852 | <b>Applicant(s)</b><br>VAHEE ET AL. |  |
|                              | <b>Examiner</b><br>VANEL FRENEL      | <b>Art Unit</b><br>3687             |  |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 07 May 2009.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-8 and 10-12 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-8 and 1012 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

**DETAILED ACTION**

Notice to Applicant

1. This communication is in response to the Appeal Brief filed on 5/07/09. Claims 1-8 and 10-12 are pending.

2. In view of the Appeal Brief filed on 5/07/09, PROSECUTION IS HEREBY REOPENED as set forth below.

To avoid abandonment of the application, appellant must exercise one of the following two options:

(1) file a reply under 37 C.F.R 1.111 (if this Office action is non-final) or a reply under 37 C.F.R 1.113 (if this Office action is final); or,

(2) request reinstatement of the appeal.

If reinstatement of the appeal is requested, such request must be accompanied by a supplement appeal brief, but no new amendments, affidavits (37 C.F.R 1.130, 1.131 or 1.132) or other evidence are permitted. See 37 C.F.R 1.193) (b)(2).

***Claim Rejections - 35 USC § 101***

3. 35 U.S.C. 101 reads as follows:  
Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

4. Claims 1-9 and 11-12 are rejected under 35 U.S.C 101 because the claimed invention is directed to non-statutory subject matter.

Claims 1-9 and 11-12 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. There is no recitation of a machine in the preamble of the claim (computer implemented method) and nominal use of a machine in the body of the claim ("continuous detection" phase) fail to make the claim statutory under 35 USC 101. Examiner suggests including some type of machine or apparatus in the preamble and the other steps.

Claim 1-9 and 11-12 are directed to a project management system, which can be interpreted in light of specification as a software or computer-executable instructions. Without reciting a computer-readable medium having said instructions embodied therein, said claim is considered to be directed to a non-statutory class of invention, and the claim has no structure whether it is directed to a method, system or apparatus claim. Here, the state of the law with respect to statutory subject matter eligibility under §101 is evolving and is presently an issue in several cases under appeal at the Federal Circuit with regard to process claims. As presently understood, based on Supreme Court precedent and recent Federal Circuit decisions. In *re Bilski et al.* 88 USPQ 2d 1385 (CAFC (2008)); *Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972); *Cochrane v. Deener*, 94 U.S. 780, 787-88 (1876)] a §101 statutory process must (1) be tied to another statutory class (e.g. such as a particular apparatus) or (2) transform underlying subject matter (such as an article or materials) to a different state or thing. If neither of these requirements is met, a method is not a patent eligible process under §101 and should be rejected as being directed to non- statutory subject matter.

For example, a method claim that recites purely mental steps (e.g. can be performed by mental process or human intelligence alone) would not qualify as a statutory process. To qualify as a §101 statutory process, the claim should (1) positively recite another statutory class (e.g. thing or product) to which it is tied (e.g. by identifying the apparatus that accomplishes the method steps) or (2) positively recite the subject matter that is being transformed (e.g. by identifying the material that is being changed to a different state).

As per claims 1-9 and 11-12, the Examiner asserts that said system steps could be performed by merely mental steps (e.g. can be performed by mental process or human intelligence alone). Here, Applicant does not adequately tie his/her steps to another statutory class to qualify as a §101 statutory process.

### **Claim Rejections - 35 USC § 112**

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:  
The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 11-12 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

7. Claim 11-12 are directed to a system. This system is comprised of two

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components – project management service and project management tool - as components. However, these components are not physical structure. Therefore, it is unclear what structure the Applicants are attempting to claim.

8. As per claims 11-12, it appears the Applicant is attempting to invoke 35 U.S.C. 112, 6th paragraph by using the phrase "means for" language, such as "means for building", "means for entering", "means for building", "means for generating" and means for using .. ". The Phrase "Means for" Is Used, but Unclear Whether the Recited Structure, Material, or Acts in the Claim Are Sufficient for Performing the Claimed Function. In order to successfully invoke the sixth paragraph, a three-prong test must be met. Namely, (1) the claim must use means-plus-function or step-plus-function language; (2) the claim itself must not provide structural limitations to the means-plus-function, or step-plus-function language; and (3) the specification must recite explicit physical structural limitations for the means-plus-function, or step-plus-function language in the claim. While the above claims pass the first two prongs of the three prong test, they do not pass the third prong.

There is no explicit recitation in the specification of any physical structures to perform the functions of the means-plus-function or step-plus-function limitations in the claim.

The only "structure" for performing the functions in the above claims appears to be computer program modules (i.e. virtual structure, not physical structure). Therefore, 35 U.S.C. 112, 6th paragraph has not been successfully invoked. The Examiner will consider the means or steps to perform the claimed functions as any means or steps,

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physical or virtual, which can perform the function.

If applicant wishes to have the claim limitation treated under 35 U.S.C. 112, sixth paragraph, applicant is required to amend the claim so that the phrase "means for" is clearly not modified by sufficient structure, material, or acts for performing the claimed function. If applicant does not wish to have the claim limitation treated under 35 U.S.C. 112, sixth paragraph, applicant is required to amend the claim so that it will clearly not be a means (or step) plus function limitation (e.g., deleting the phrase "means for").

### ***Conclusion***

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to VANEL FRENEL whose telephone number is (571)272-6769. The examiner can normally be reached on 6:30am-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Matthew Gart can be reached on 571-272-3955. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business

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Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Nanel Frenel/

Primary Examiner

Examiner, Art Unit 3687

August 26, 2009